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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,445	11/20/2000	Warren Adams	249768040US	2880

25096 7590 10/08/2004

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EXAMINER
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JASMIN, LYNDIA C

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/718,445

Applicant(s)

ADAMS ET AL.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-43 and 67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-43 and 67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 16, 2004 has been entered.

Amendment received May 10, 2004 has been acknowledged.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 25-28, 31, 33-43 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (6,611,814 B1) in view of Nelson et al. (200/0042775 A1).

Lee et al. discloses a method in a computing system (via an online store) for notifying a first user (via recipient 140 which is also a shopper allowing other shoppers and online store to use their wish list) about a purchase made by a second user (shoppers 101 which could also be a list owner), including: detecting that the second user has purchased an item (via checkout process step 216; tracking device 1406, as illustrated in another embodiment), determining that the first user (recipients 140) has a purchase notification relationship with the second user (shoppers 101) established independently from the purchase of the item by the second user (via virtual wish list provider 130; col. 9, lines 33-41).

Lee et al. further discloses receiving an order from the second user for the item (via checkout process, col. 13, lines 11-12), receiving an order from a third user (via another shopper) ordering the item as a gift for the second user (col. 12, lines 18-21). Lee et al. also discloses establishing for the first user a purchase notification relationship with the second user in response to an instruction from the first/second user (via the creation of a recipient list of which owns wish list on the server), and establishing for the first user a purchase notification relationship with the second user in response to a comparison of characteristics of the first and second users (col. 6, lines 19-35).

As per claim 43, Lee et al. further discloses the purchase detection subsystem (via the checkout process step 216) detects that the second user has purchased an item for a recipient other than the first user (since one or more persons are on the recipient list 702 via receivers 140) (further, as illustrated in Figure 8, the shopper 101, viewed as the second user, can make transactions for purchasing one or more product from their owned wish list) (col. 12, lines 12-26), a purchase notification relationship subsystem (via online store 120) that determines that the first user has a purchase notification relationship with the second user (col. 6, lines 42-53).

However, Lee et al. fails to explicitly disclose providing to the first user a notification that the second user has purchased the item, and receiving input from the second user indicating that the second user owns the item.

Nelson et al. discloses the concept of notifying a recipient of purchased made by a purchaser (114) and identifying the purchaser to the recipient (110; is implied via sending a gift card). The notifying concept is via gift card electronically generated and sent in an e-mail message, or the notification may be via an e-mail message that is transmitted to the recipient, or a physical gift card provided (such as via postal mail gift card). Nelson et al. further discloses an input via payment mechanism that the purchaser has paid for the transaction and an invoice is generated. Nelson et al further discloses determining if an initial payment is required for the commodity before completed the process of registering for a registry which could be viewed as the recipient being also the purchaser by making a down payment for the commodity. List

of items either available or unavailable can be viewed at client computer (122) via exchanging information with server computer (126).

From this teaching of Nelson et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the users online store and wish list of Lee et al. to include notifying of the receiving user as taught by Nelson et al. in order to indicate that a product has been purchased and thereby delete it or put the product unavailable from a wish list.

5. Claims 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. in view of Nelson et al., and further in view of Ewing (202/0095298 A1).

The Lee et al. and Nelson et al. combination discloses all the elements of the claimed invention but fails to explicitly disclose the common and well-known variation of sending messages via instant message, pager message and voice mail message.

Ewing discloses the concept of having member interacting with other members over the internet using text, audio or voice chat; instant messaging; or, e-mail, and the member desires to send the other member a gift.

From this teaching of Ewing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the Lee et al. and Nelson et al. combination to include the different ways of sending notification message to another party as taught by Ewing in order to engage in real time conversation.

### ***Response to Arguments***

6. Applicant's arguments filed May 10, 2004 have been fully considered but they are not persuasive. After carefully review of the Nelson et al. prior art, the Examiner asserts

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that sending a notification, which identifies the sender, is implied in the Nelson reference. It is the Examiner's position that Nelson discloses notification (150), which may be in the form of gift card, or may be an e-mail message transmitted to the recipient, thus one of ordinary skill in the art would know that a gift card bears the identification of the sender and the amount contributed. Therefore, the rejection of Lee et al. in view of Nelson et al. has been withdrawn.

### ***Conclusion***

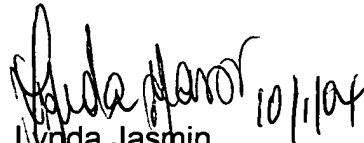
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schwartz et al., Tornabene et al. Mattaway are cited or using the concept of group sharing over a network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lynda Jasmin  
Primary Examiner  
Art Unit 3627

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